

REMARKS

This Response is submitted in reply to the Office Action dated November 28, 2003. Claims 1, 6, 7, 13, 14, 19, 21, 25, 26, 35, 36 and 39 have been amended. New Claims 42 to 63 have been added. No new matter has been added by any of the amendments made herein. A Petition for a one-month extension of time to respond to the Office Action is submitted herein. A check in the amount of \$678 is submitted herein to cover the fees for the one-month extension and the newly added claims. Please charge Deposit Account 02-1818 for any insufficiency or to credit any overpayment.

Claims 1 to 41 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,190,255 to Thomas et al. ("Thomas") in view of U.S. Patent No. 6,315,660 to DeMar et al. ("DeMar"). Applicants respectfully disagree with this rejection.

The Office Action states that "Thomas does not expressly disclose a supplementing award including an award is automatically provided to the player and at least one additional award generation which automatically provides an independent additional award to the player of the supplementing award as recited in Claims 1, 13, 19, 21-22, 25, and 26 . . ." (Final Office Action, page 3). The Office Action relies on DeMar to remedy the deficiencies of Thomas. The Office Action states that DeMar teaches a supplementing award including an award that is automatically provided to the player and at least one additional award generation which automatically provides an independent additional award to the player for the supplementing award. The Office Action states that in DeMar, when a player lands on "chance" or "community chest" the

gaming device generates an award and advances a player to a different space on the board to receive an additional award. The Office Action on page 5 concludes that:

[I]t would have been obvious to one of ordinary skill in the art at the time of the applicants' invention was made to modify Thomas to include a supplementing award including an award is automatically provided to the player and at least one additional award generation which automatically provides an independent additional award to the player of the supplementing award . . . To do so would provide game players with a guaranteed win in an increased payout outcome.

Applicants respectfully disagree with this conclusion because the combination of Thomas and DeMar does not disclose, teach or suggest a gaming device including a supplementing award where the supplementing award provides an award which is automatically provided to the player and at least one additional award generation which automatically provides an additional award to the player.

Thomas discloses a gaming machine having a basic mode and a bonus mode. The gaming machine initiates the bonus game upon the occurrence of a special start-bonus game outcome in the basic mode. In a bonus game, the gaming machine presents a plurality of windows 101 to 130 to the player (Col. 10, lines 25 to 30). The gaming machine then enables the player to pick one of the windows. The gaming machine provides credits to the player for each selection made by the player that does not include an end-bonus outcome (See the Abstract). When a player picks a selection including the end-bonus outcome, the bonus game ends. Therefore, the gaming device enables the player to continue to pick selections and accumulate credits until the player picks a selection including the end-bonus outcome.

DeMar discloses a gaming machine having a board game theme. Specifically, DeMar discloses a gaming machine having a game theme based on the board game "Monopoly." The gaming device enables a player to play the monopoly game similar to the play of the board game. In one embodiment, the gaming machine enables a player to select a token. A central processing unit illuminates a starting station or location on the game board and then successively illuminates stations around the board in step-wise fashion based on events that occur in the game. When the token ends or is positioned on a station including the word "chance" or "community chest" the CPU triggers an animation on a video display that shows the top card of a piled card flipping up to reveal the "chance" or "community chest" outcome. (See Col. 22, lines 50 to 67). The "chance" and "community chest" outcomes include awards of fixed coin values or the gaming machine moves the player to a new space (i.e., advances the player to boardwalk or another station). The player accumulates awards in the bonus game which are added to the player's total award.

A person of ordinary skill in the art would not be motivated to combine Thomas and DeMar to teach the present invention because there is no teaching or suggestion in these references to make such a combination. Thomas discloses a game including a plurality of selections where the player picks these selections to accumulate awards until the player picks an end-game outcome. Thomas does not teach or suggest providing a supplementing award associated with one of the selections. DeMar discloses a bonus game based on the Monopoly® board game which randomly moves a token around a board and provides awards associated with the different stations or locations on the board. This bonus game disclosed by DeMar does not teach or

suggest enabling a player to pick a selection from a plurality of selections. Moreover, DeMar does not teach or suggest a gaming machine that provides a supplementing award when a player lands on one or more of the stations on the game board. Thomas discloses a selection game where the gaming device enables a player to pick one or more selections from a plurality of player selectable selections. On the contrary, DeMar discloses a board game as described above, and not a selection based game, where the gaming machine moves a player's token about the board to provide credits to the player. As a result, a person of ordinary skill in the art would not be motivated to combine the different games disclosed by Thomas and DeMar.

In addition, neither Thomas nor DeMar teaches or suggests a supplementing award as in the claimed invention. Therefore, a person of ordinary skill in the art would also not be motivated to combine Thomas and DeMar to teach or suggest a supplementing award where neither reference discloses such an element.

Additionally, as discussed during the interview, applicants have amended the claims to further distinguish over the combination of these references.

Amended Claim 1 is directed to a gaming device including a processor, a game controlled by the processor and displayed by a display device, a plurality of selections in the game, and a plurality of awards associated with the selections. The gaming device includes at least one supplementing award associated with at least one of the selections where the supplementing award is adapted to be provided to a player by the processor when the player picks the selection associated with the supplementing award. Each supplementing award includes an award which is automatically provided to the player and at least one additional award generation which automatically provides an

independently randomly determined guaranteed additional award to the player for the supplementing award.

As agreed upon during the telephone interview, amended Claim 1 requires the additional award to be independently randomly determined and guaranteed to be provided to the player. Accordingly, Applicants respectfully submit that amended Claim 1 is patentably distinguished over the combination of Thomas and DeMar. Therefore, amended Claim 1 and Claims 2 to 12, which depend from amended Claim 1, are patentably distinguished from the combination of Thomas and DeMar and are in condition for allowance.

Amended Claim 13 is directed to a gaming device including a processor, a game controlled by the processor and displayed by a display device, a plurality of selections in the game and a plurality of awards associated with the selections. The gaming device also includes at least one supplementing award associated with the selections and adapted to be provided to a player by the processor, where the supplementing awards includes an award which is automatically provided to the player and a random award generation which automatically provides an independently randomly determined guaranteed additional award to the player for the supplementing award.

As described above, the combination of Thomas and DeMar does not disclose, teach or suggest a gaming device including a supplementing award which automatically provides an award and a random award generation which provides an independently randomly determined guaranteed additional award to a player when the player picks a selection associated with the supplementing award. For at least these reasons, the combination of Thomas and DeMar does not disclose, teach or suggest the claimed

invention. Therefore, amended Claim 13 and Claims 14 to 18, which depend from independent Claim 13, are each patentably distinguished over the combination of Thomas and DeMar and are in condition for allowance.

Amended Claim 19 is directed to a gaming device including a processor, a game controlled by the processor and displayed by a display device, a plurality of awards in the game and a plurality of supplementing awards in the game. The supplementing awards are adapted to be provided to a player by the processor. Each of the supplementing awards includes one of the awards which is automatically provided to a player and an award generation that chooses one of the plurality of awards which is an independently randomly determined guaranteed additional award automatically provided to the player for the supplementing award. As described above, the combination of Thomas and DeMar does not disclose, teach or suggest a plurality of supplementing awards with automatically provide an award from a plurality of awards to the player and an award generation that automatically provides an independently randomly determined guaranteed additional one of the awards to the player. For at least these reasons, amended Claim 19 and Claim 20, which depend from Claim 19, are each patentably distinguished over the combination of Thomas and DeMar and are in condition for allowance.

Amended Claim 21 is directed to a gaming device that includes a display device and a processor adapted to communicate with the display device. The display and processor are adapted to enable a player to pick at least one selection from a plurality of selections, generate a supplementing award associated with one of the selections, automatically provide an award to the player associated with the supplementing award

and provide an award generation associated with the supplementing award if the player picks the selection associated with the supplementing award wherein the award generation automatically provides an independently randomly determined guaranteed additional award to the player. For the same reasons stated above, the combination of Thomas and DeMar does not disclose, teach or suggest a gaming device that generates a supplementing award associated with one of the selection, wherein the supplementing award includes an award which is automatically provided to a player and an award generation which automatically provides an independently randomly determined guaranteed additional award to the player. Therefore, amended Claim 21 and Claims 22 to 24, which depend from Claim 21, are each patentably distinguished over the combination of Thomas and DeMar and are in condition for allowance.

Amended Claim 25 is directed to a gaming device including a display device and a processor adapted to communicate with the display device. The display device and processor are adapted to enable a player to pick at least one selection from a plurality of selections, generate a supplementing award associated with one of the selection, automatically provide an award to the player associated with the supplementing award if the player picks the associated selection with the supplementing award and provide an award generation associated with the supplementing award if the player picks the associated selection with the supplementing award wherein the award generation automatically yields an independently randomly determined guaranteed additional award provided to the player and another supplementing award which automatically provides a further independently randomly determined guaranteed award to the player. For the reasons provided above, the combination of Thomas and DeMar does not

disclose, teach or suggest a gaming device including a plurality of selections including a supplementing award wherein the supplementing award automatically provides an award to a player and also an award generation which provides another supplementing award to a player which automatically provides a further independently randomly determined guaranteed award to the player. Therefore, amended Claim 25 is patentably distinguished over the combination of Thomas and DeMar and is in condition for allowance.

Amended Claim 26 is directed to a gaming device including a processor, a game controlled by the processor and displayed by a display device, a plurality of selections in the game, and a plurality of awards associated with the selections. The gaming device also includes at least one supplementing award associated with the selection where the supplementing award includes an award which is automatically provided to the player and at least one additional award generation which automatically provides an independently randomly determined guaranteed additional award to a player. The gaming device further includes a probability of selecting an award associated with each of the awards. The processor is operable to enable a player to pick one of the selections, randomly associate one of the awards which the pick selection based on the probabilities, automatically provides an award and at least one additional award generation that provides an independently randomly determined guaranteed additional award to the player when the supplementing award is associated with the pick selection and automatically provides one of the awards to the player when the supplementing award is not associated with the pick selection. As described above, the combination of Thomas and DeMar does not disclose, teach or suggest the elements of amended

Claim 26. Therefore, amended Claim 26 and Claims 27 to 41, which depend from Claim 26, are each patentably distinguished over the combination of Thomas and DeMar and are in condition for allowance.

Newly added Claim 42 is directed to a method of operating a gaming device controlled by processor. The method includes enabling a player to pick at least one selection from a plurality of selections, generating a supplementing award associated with one of the selections, automatically providing an award to the player associated with the supplementing award if the player picks a selection associated with the supplementing award and providing an award generation associated with the supplementing award if the player picks the selection associated with the supplementing award which automatically provides an independently randomly determined guaranteed additional awards to the player. New Claim 42 and Claims 43 to 53, which depend from Claim 42, are each patentably distinguished over the combination of Thomas and DeMar and are in condition for allowance.

Newly added Claim 54 is directed to a method of operating a gaming device controlled by a processor. The method includes enabling a player to pick at least one selection from a plurality of selections, generating a supplementing award associated with one of the selections, automatically providing an award to the player associated with the supplementing award if the player picks the selection associated with the supplementing award and providing an award generation associated with the supplementing award if the player picks the selection associated with the supplementing award wherein the award generation automatically yields an independently randomly determined guaranteed additional award provided to the player in another

supplementing award which automatically provides a further independently randomly determined guaranteed award to the player for the supplementing award. New Claim 54 and Claims 55 to 63, which depend from Claim 54, are each patentably distinguished over the combination of Thomas and DeMar and are in condition for allowance.

An earnest endeavor has been made to place the application in condition for a formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this response, Applicants respectfully request that the Examiner contact the undersigned attorney.

Respectfully submitted,

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